

**C. APPLICANT'S COMMENTS**

Claims 1-4, 10-13, 17, 19-21 are pending in this Application, with Claims 5-9, 14-16, 18, 22-38 canceled, and Claims 39, 40 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-4, 10-13, 17, 19-21 and favorable consideration of Claims 39, 40 is respectfully requested.

The Examiner rejected the claims in view of Khosrowpour, Mitra, Przilas and Damerow. However, none of these references teach or suggest the features as claimed in independent Claims 1, 39 and 40. In particular, none of the cited patents teach a transition board that “manipulates data being transferred between said I/O board and said backplane board”. Furthermore, none of the cited patents teach a combination of an I/O board, a transition board and a backplane board as claimed in the applicant's claims. These are significant features of the present invention that should not be overlooked by the Examiner in determining the allowability of the present claims.

The Applicant has amended independent Claim 1 to include the features of the canceled dependent claims. The Applicant respectfully submits that none of the cited patents teach or suggest the following:

1. (Currently Amended) An input/output transition board system for transferring data between an I/O board and a backplane board, comprising:
  - an I/O board having at least one I/O connector and at least one front I/O connector;
  - a transition board having at least one rear connector connectable to said at least one front I/O connector and at least one front connector; and
  - a backplane board having at least one rear backplane connector connectable to said at least one front connector;
- an enclosure capable of receiving said I/O board, said transition board and said backplane board, wherein said enclosure is comprised of a spray cooling system;
- wherein said enclosure is sealed;

- wherein said transition board manipulates data being transferred between said I/O board and said backplane board;
- wherein said transition board includes at least one electronic device;
- wherein said transition board is active;
- wherein said backplane board has at least one socket;
- wherein said at least one socket is on a side opposite of said at least one rear backplane connector;
- wherein said at least one socket is in communication with said at least one rear backplane connector;
- wherein said I/O board is attachable to an interior surface of an enclosure;
- wherein said at least one I/O connector is extendable through a corresponding opening within said enclosure;
- wherein said at least I/O connector is hermetic.

If the Examiner is inclined to combine the cited references, the Applicant respectfully submits the following.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.<sup>1</sup> When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal.<sup>2</sup> “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”<sup>3</sup>

“To establish a *prima facie* case of obviousness, three basic criteria must be met.”<sup>4</sup> First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the

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<sup>1</sup> *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

<sup>2</sup> *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

<sup>3</sup> *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.<sup>5</sup>

“Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination.”<sup>6</sup> “An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art.”<sup>7</sup> “As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention**, the **subject matter of the references**, the extent to which they are **in the same or related fields of technology**, the **nature of the advance** made by the applicant, and the **maturity and congestion of the field**.”<sup>8</sup> Obviousness requires proof “that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed.”<sup>9</sup>

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

‘Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if

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<sup>4</sup> MPEP §706.02(j).

<sup>5</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>6</sup> *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) (“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.”); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fritch*, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

*Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

For these reasons, among others, the combination of Khosrowpour, Mitra, Przilas and Damerow cannot suggest the combination of features in applicant's Claims 1, 39, 40 and it is therefore submitted that the rejection against these claims should be withdrawn and Claims Khosrowpour, Mitra, Przilas and Damerow allowed.

#### D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is

respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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